UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,681	07/08/2003	Jung Chung Lai	0EKM-104478	9816

30764 7590 02/09/2007

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

EXAMINER	
AUGHENBAUGH, WALTER	
ART UNIT	**PAPER NUMBER**
1772	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/615,681	LAI ET AL.	
	Examiner	Art Unit	
	Walter B. Aughenbaugh	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/16/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 1-17, in the reply filed on November 3, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

2. The information disclosure statement filed October 16, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of each of the documents listed under "OTHER DOCUMENTS" on each of pages 1 through 4 of the PTO-1449 form are not in the IFW file.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "104" and "106" have both been used to designate the outsole in Fig. 1 (while paragraph 25 of the specification uses reference character 104 to refer to the outsole and 106 to refer to the material that the outsole 104 is "made from", both reference characters 104 and 106 appear to point to the same component of the shoe in Fig. 1: there is no need to identify the material that the outsole 104 is "made from" in the Figures because the outsole 104 necessarily comprises a material). Corrected drawing sheets in compliance with 37 CFR

1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "104" and "108" have both been used to designate the outsole in Fig. 4 (while paragraph 28 of the specification uses reference character 104 to refer to the outsole and 108 to refer to the material of the outsole 104, both reference characters 104 and 108 appear to point to the same component of the shoe in Fig. 4: there is no need to identify the material of the outsole 104 in the Figures because the outsole 104 necessarily comprises a material). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: paragraph 30 discusses reference characters 100 and 110 in regard to Fig. 7, but these reference characters do not appear in Fig. 7, and paragraph 33 discusses reference character 104 in regard to Fig. 8, but this reference character does not appear in Fig. 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The use of the trademark "ENGAGE" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation of the trademark "ENGAGE" renders the claim indefinite because it appears that the recitation of the trademark "ENGAGE" is being used in claim 2 as a limitation to identify or describe a particular material. MPEP 2173.05(u). This appears to be the case since the specification refers to a material under the trademark "ENGAGE" as a single material ("A preferred polyene elastomer", "The ENGAGE polyene elastomer is a kind of ethene...", paragraph 21 of specification). As stated in MPEP:

> [i]f the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

MPEP 2173.05(u).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677).

In regard to claim 11, Allen et al. teach an article of footwear (shoe, item 10, Fig. 1, 2 and 6) comprising an upper, item 12, and a sole, item 14, wherein the sole has an outsole for directly contacting a ground surface (outsole, item 60, Fig. 6) (col. 5, lines 39-41 and col. 6, lines 64-67). Allen et al. teach that the article of footwear comprises at least one element (frame, item 50) (col. 6, lines 22-45, Fig. 4-6). Allen et al. teach that the article of footwear comprises at least one cleat receptacle (spike sockets/receptacles, item 54) (frame, item 50) (col. 6, lines 22-29, col. 7, lines 44-52 and Fig. 6). Allen et al. teach that the outsole, item 60, comprises a material (which corresponds to Applicant's claimed "material of the outsole") that is less hard than the at least one element (frame, item 50) because Allen et al. that the material of the frame, item 50, is harder than the material of the outsole, item 60 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13). The material of the outsole, item 60, of Allen et al. is less dense than the at least one element (frame, item 50) because the material of the outsole, item 60, of Allen et al. is softer than the material of the frame, item 50 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13), and therefore serves as a cushioning material (col. 7, lines 14-17) and provides more of a cushioning

effect than frame, item 50, provides in the combination of the frame and outsole (col. 7, lines 14-17), so the density of the outsole, item 60, is necessarily less than that of the frame, item 50, since the cushioning outsole is more easily compressed (there are necessarily spaces, that are either visible to the naked eye or not, that exist in the cushioning material which allow the cushioning material to compress when a sufficient force is applied to the cushioning material, which render the cushioning material less dense that the material of the frame, which is not a cushioning material). The material of the outsole, item 60, is compatible for compression molding with the at least one element (frame, item 50) because the outsole and the frame coexist in the same final product (Fig. 4-6). The cleat receptacles (spike sockets/receptacles, item 54) are accessible for attachment of a non-metal cleat (col. 9, lines 9-22 and Fig. 6). The recitations "compression molded with the outsole" (line 4) and "compression molded with the at least one element" (line 5) are method limitations that have not been given patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. The recitation "compression molded with" (lines 4 and 5) does not recite any structural or compositional limitations of the claimed final product or of any components of the claimed final product. Allen et al. teach that the frame is preferably comprised of a polyurethane or thermoplastic polyurethane (col. 6, lines 29-32).

Allen et al. fail to teach that the at least one element (frame, item 50) comprises solid ethylene vinyl acetate.

Briant et al., however, disclose a detachable cleat system that is manufactured from any suitable polymeric material or combination of polymeric materials, either with or without reinforcement (col. 8, lines 12-16), where suitable polymeric materials include polyurethanes

such as thermoplastic polyurethanes, ethylene vinyl acetate and polyethylenes (col. 8, lines 16-24). Therefore, one of ordinary skill in the art would have recognized to have replaced the thermoplastic polyurethane of the frame of Allen et al. with a composition comprising ethylene vinyl acetate since ethylene vinyl acetate and thermoplastic polyurethane are both suitable materials for use in the formation of a detachable cleat system for athletic shoes as taught by Briant et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the thermoplastic polyurethane of the frame of Allen et al. with a composition comprising ethylene vinyl acetate since ethylene vinyl acetate and thermoplastic polyurethane are both suitable materials for use in the formation of a detachable cleat system for athletic shoes as taught by Briant et al.

In regard to claim 12, Allen et al. teach that the second material of outsole, item 60, comprises thermoplastic polyurethane or a thermoplastic polyurethane/thermoplastic rubber blend (which is a rubber and a thermoplastic polyurethane) (col. 6, line 66-col. 7, line 3).

In regard to claim 13, Allen et al. teach that the second material of outsole, item 60, comprises a thermoplastic polyurethane/thermoplastic rubber blend and therefore both a rubber and a thermoplastic polyurethane (col. 6, line 66-col. 7, line 3).

In regard to claims 14 and 15, the at least one element (frame, item 50) of Allen et al. comprises a plurality of elements (the portion of frame, item 50, that corresponds to sections 30, 32 and 34 in Fig. 2 and the section consisting of two spikes, 40d and 40g, in section 32 in Fig. 2: comparison of the location of frame 50 in Fig. 6 with Fig. 2 makes it clear that spikes 40a-q sit

on top of frame 50, col. 5, line 63-col. 6, line 4 and col. 6, line 11-22), and both of these elements of the plurality of elements includes a cleat receptacle, item 54 (Fig. 2 and 6).

11. Claims 1, 3-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677) and in further view of McKay et al. (USPN 5,869,591).

In regard to claim 1, Allen et al. teach an article of footwear (shoe, item 10, Fig. 1, 2 and 6) comprising an upper, item 12, and a sole, item 14, wherein the sole has an outsole for directly contacting a ground surface (outsole, item 60, Fig. 6) (col. 5, lines 39-41 and col. 6, lines 64-67). Allen et al. teach that the article of footwear comprises at least one element (frame, item 50) (col. 6, lines 22-45, Fig. 4-6). Allen et al. teach that the outsole, item 60, comprises a material (which corresponds to Applicant's claimed "second material of the outsole") that is less hard than the at least one element (frame, item 50) because Allen et al. that the material of the frame, item 50, is harder than the material of the outsole, item 60 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13). The material of the outsole, item 60, of Allen et al. is less dense than the at least one element (frame, item 50) because the material of the outsole, item 60, of Allen et al. is softer than the material of the frame, item 50 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13), and therefore serves as a cushioning material (col. 7, lines 14-17) and provides more of a cushioning effect than frame, item 50, provides in the combination of the frame and outsole (col. 7, lines 14-17), so the density of the outsole, item 60, is necessarily less than that of the frame, item 50, since the cushioning outsole is more easily compressed (there are necessarily spaces, that are either visible to the naked eye or not, that exist in the cushioning material which allow the cushioning material to compress when a sufficient force is applied to the cushioning material,

which render the cushioning material less dense that the material of the frame, which is not a cushioning material). The material of the outsole, item 60, is compatible for compression molding with the at least one element (frame, item 50) because the outsole and the frame coexist in the same final product (Fig. 4-6). The recitation "compression molded with the outsole" (line 4) is a method limitation that has not been given patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. The recitation "compression molded with" (line 4) does not recite any structural or compositional limitations of the claimed final product or of any components of the claimed final product. Allen et al. teach that the frame is preferably comprised of a polyurethane or thermoplastic polyurethane (col. 6, lines 29-32) and that the frame is comprised of spike (cleat) receptacles (col. 6, lines 23-29).

Allen et al. fail to teach that the frame is formed from a material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer and approximately 20% synthetic rubber.

Briant et al., however, disclose a detachable cleat system that is manufactured from any suitable polymeric material or combination of polymeric materials, either with or without reinforcement (col. 8, lines 12-16), where suitable polymeric materials include polyurethanes such as thermoplastic polyurethanes, ethylene vinyl acetate and polyethylenes (col. 8, lines 16-24).

McKay et al., furthermore, disclose a composition in the form of shoe soles (and therefore for use as a material in shoes), athletic sponge pads and heat insulation (col. 54, lines 32-34) that comprises olefin polymers including α-olefin homopolymers or interpolymers, ethylenes, propylenes, ethylene-propylene interpolymers, ethylene vinyl acetate, block

elastomers and combinations thereof (col. 20, line 58-col. 21, line 6 and col. 3, line 43-col. 4, line 26), where the interpolymers preferably comprise comonomers such as 1-butane, 4-methyl-1-pentene, 1-hexene, 1-octene or C_4-C_{20} dienes (polymerization of any of these comonomers results in a polyene) (col. 18, line 54-col. 19, line 30, in particular, col. 18, lines 54-60 and col. 19, lines 14-30).

Therefore, one of ordinary skill in the art would have recognized to have replaced the thermoplastic polyurethane of the frame of Allen et al. with a composition comprising ethylene vinyl acetate since ethylene vinyl acetate and thermoplastic polyurethane are both suitable materials for use in the formation of a detachable cleat system for athletic shoes as taught by Briant et al. and to have used the composition comprising a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer of McKay et al. as the composition of the frame of Allen et al. since a composition formed from a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer is a well known composition for use in formation of athletic shoes as taught by McKay et al.

In regard to the claimed relative amounts of ethylene vinyl acetate, polyene elastomer and synthetic rubber, the claimed relative amounts fall within the teaching of McKay et al. of "any combination thereof" at col. 20, line 65 (col. 20, lines 58-65). Furthermore, "[g]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical." MPEP 2144.05 II.A.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the thermoplastic polyurethane of the frame of Allen et al. with a

composition comprising ethylene vinyl acetate since ethylene vinyl acetate and thermoplastic polyurethane are both suitable materials for use in the formation of a detachable cleat system for athletic shoes as taught by Briant et al. and to have used the composition comprising a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer of McKay et al. in the claimed relative amounts as the composition of the frame of Allen et al. since a composition formed from a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer is a well known composition for use in formation of athletic shoes as taught by McKay et al.

In regard to claim 3, Allen et al., Briant et al. and McKay et al. teach the article as discussed above in regard to claim 1. While Allen et al. teach that the outsole 60 is formed of ethylene vinyl acetate (EVA) (col. 7, lines 12-13), Allen et al. fail to teach that the outsole 60 comprises a blowing agent. McKay et al., however, discloses that the composition in the form of shoe soles (and therefore for use as a material in shoes), athletic sponge pads and heat insulation (col. 54, lines 32-34) is a foamed composition (col. 54, lines 30-32), and that a blowing agent may be used to form the foamed composition (col. 24, lines 5-19). Therefore, one of ordinary skill in the art would have recognized to have used a blowing agent to have foamed the EVA of the outsole 60 of the article taught by Allen et al., Briant et al. and McKay et al. since a foamed EVA composition (col. 20, lines 58-65) is a well known composition for use in formation of athletic shoes as taught by McKay et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a blowing agent to have foamed the EVA of the outsole 60 of the article taught by Allen et al., Briant et al. and McKay et al. since a foamed EVA composition (col. 20,

lines 58-65) is a well known composition for use in formation of athletic shoes as taught by McKay et al.

In regard to claim 4, Allen et al. teach that the second material of outsole, item 60, comprises thermoplastic polyurethane or a thermoplastic polyurethane/thermoplastic rubber blend (which is a rubber and a thermoplastic polyurethane) (col. 6, line 66-col. 7, line 3).

In regard to claim 5, Allen et al. teach that the second material of outsole, item 60, comprises a thermoplastic polyurethane/thermoplastic rubber blend and therefore both a rubber and a thermoplastic polyurethane (col. 6, line 66-col. 7, line 3).

In regard to claim 6, the at least one element (frame, item 50) of Allen et al. is outwardly visible on the sole (Fig. 6).

In regard to claim 7, the at least one element (frame, item 50) of Allen et al. comprises a plurality of elements (the portion of frame, item 50, that corresponds to sections 30, 32 and 34 in Fig. 2 and the section consisting of two spikes, 40d and 40g, in section 32 in Fig. 2: comparison of the location of frame 50 in Fig. 6 with Fig. 2 makes it clear that spikes 40a-q sit on top of frame 50 (col. 5, line 63-col. 6, line 4 and col. 6, line 11-22), and both of these elements of the plurality of elements are outwardly visible on the sole (Fig. 2).

In regard to claim 10, the at least one element (frame, item 50) of Allen et al. provides torsional reinforcement for the sole since Allen et al. teaches that the combination of outsole 60 and frame 50 provides good crosswise stability (col. 7, lines 14-17).

12. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677) and in further view of Safdie (USPN 5,771,605).

Allen et al. and Briant et al. teach the article of footwear as discussed above in regard to claim 11.

Allen et al. and Briant et al. fail to teach that the at least one element (frame, item 50) of Allen et al. includes a foil layer that is visible on the sole as claimed in claim 16, or that the at least one element (frame, item 50) of Allen et al. includes an electroplated member that is visible on the sole as claimed in claim 17.

Safdie, however, in regard to claim 16, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12) which may also be considered to be a foil since Safdie teaches that it is cut from a sheet of metal (col. 5, lines 36-42). Therefore, one of ordinary skill in the art would have recognized to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image as taught by Safdie.

Safdie, however, in regard to claim 17, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12), where the plate 22 is made of, or coated with, an electroplated metal (col. 5, lines 53-59). Therefore, one of ordinary skill in the art would have recognized to have included an image-display system that comprises an electroplated member of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises an electroplated member of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image as taught by Safdie.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677) and in further view of McKay et al. (USPN 5,869,591) and in further view of Hurley et al. (USPN 5,938,878).

Allen et al., Briant et al. and McKay et al. teach the article of footwear as discussed above in regard to claim 1.

While McKay et al. teach that the composition formed from a combination of ethylene vinyl acetate, polyolefin (polyene) interpolymer and block elastomer is foamed (col. 54, lines 30-34), Allen et al., Briant et al. and McKay et al. fail to explicitly teach that the polyolefin (polyene) elastomer is ENGAGE™.

Hurley et al., however, disclose that is ENGAGE™ is a suitable polyolefin resin for use as a component of foamed resins that include EVA resin and ethylene-propylene rubber or ethylene-propylene diene rubber (col. 9, line 65-col. 10, line 3, col. 9, lines 44-46 and col. 11, lines 25-40). Therefore, one of ordinary skill in the art would have recognized to have used ENGAGE™ as the polyene in the foamed resin of McKay et al. since ENGAGE™ is a suitable polyolefin resin for use as a component of foamed resins that include EVA resin and ethylene-propylene rubber as taught by Hurley et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have have used ENGAGE™ as the polyene in the foamed resin of McKay et al. since ENGAGE™ is a suitable polyolefin resin for use as a component of foamed resins that include EVA resin and ethylene-propylene rubber as taught by Hurley et al.

14. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677) and in further view of McKay et al. (USPN 5,869,591) and in further view of Safdie (USPN 5,771,605).

Allen et al., Briant et al. and McKay et al. teach the article of footwear as discussed above in regard to claim 1.

Allen et al., Briant et al. and McKay et al. fail to teach that the at least one element (frame, item 50) of Allen et al. includes a foil layer that is outwardly visible on the sole as

claimed in claim 8, or that the at least one element (frame, item 50) of Allen et al. includes an electroplated member that is outwardly visible on the sole as claimed in claim 9.

Safdie, however, in regard to claim 8, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12) which also may be considered a foil since Safdie teaches that it is cut from a sheet of metal (col. 5, lines 36-42). Therefore, one of ordinary skill in the art would have recognized to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (outwardly visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (outwardly visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image as taught by Safdie.

Safdie, however, in regard to claim 9, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12), where the plate 22 is made of, or coated with, an electroplated metal (col. 5,

lines 53-59). Therefore, one of ordinary skill in the art would have recognized to have included an image-display system that comprises an electroplated member of Safdie that is suitably sized on an exposed (outwardly visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises an electroplated member of Safdie that is suitably sized on an exposed (outwardly visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image as taught by Safdie.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Walter B. Aughenbaugh
02/05/07

Walter B. Aughenbaugh
02/05/07